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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,093	05/02/2001	Henry Michaels Beisner		5735

7590

08/26/2003

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EXAMINER

ANDREA, BRIAN K

ART UNIT

PAPER NUMBER

3662

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/847,093

Applicant(s)

BEISNER, HENRY MICHAELS

Examiner

Brian K Andrea

Art Unit

3662

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Continuation of 5:

The substitute specification submitted with the amendment filed 13 August 2003 has not been entered. The issue is that this most recent specification is an attempt to amend a substitute specification filed on 25 November 2002 which was never entered because of new matter issues. The current specification under review is the original specification filed with the application.

The Applicant, on page 2 of the amendment filed 13 August 2003, argues that the examiner's original objection to the specification was improper and that, "if you can understand the contents of [the book by Monson H. Hayes submitted with the arguments], you can understand the original application." Specifically, Applicant has argued that "the examiner had trouble understanding the process of converting the signal from analog to complex digital samples" (in the second paragraph on page 2); that "the examiner does not understand the rudiments of digital filters" (third paragraph on page 2); and that "if the examiner was familiar with the contents of Hayes that is, had ordinary skill in the art of digital signal processing, he should have had no difficulty understanding the original application."

In response, the original objection by the Examiner stated that the following items were not understood in the specification:

- (1). Calculation and application of the filter weights used in the filter; and
- (2). How the removal of multipath is accomplished using the filter of the present invention.

This objection was not based on the fact that elements such as "analog to digital processing" or "digital filtering are not understood. The objection to the specification was made because, while each individual element is easily understood by someone of ordinary skill in the art, the application and synthesis of each element of processing in the present invention is not readily understood from the disclosure provided by the Applicant. For example, it is understood how the filter weights are calculated but it is not understood how they are applied to remove the multipath from the received signal. The use of filters is well known in the art and it is understood that filtering is used for removing the multipath from the received signal in the present invention. However, this is not enough to fully disclose the workings of the invention. It must be understood how each element of the filtering process is used in the present application and how each element works with other elements to accomplish the removal of multipath from the signal.

Additionally, Applicant alleges on page 2, paragraph 5 of the current response (filed 13 August 2003) that the matter that Applicant attempted to amend into the specification in the previous amendment (filed 25 November 2002), which was subsequently not entered due to a new matter objection, was/is "a specific, nonessential example."

In response, the Examiner contends that the Applicant's attempt to add new matter did not only consist of an example. The new matter rejection cited:

- (1). the explanation of the coefficients and how they are determined;
- (2). The mathematics for determining the coefficients; and
- (3). The mathematics for removing the multi-path and restoring the original signal.

The specification as originally filed was/is deficient in that it lacked a proper explanation of the workings of each element of the invention in addition to a proper explanation of how each element "works together" to accomplish the removal of the multipath from a received signal. When an amendment to the specification is required to address deficiencies such as these, essential subject matter cannot be added without filing a Continuation in Part (CIP). In the present case, the original specification lacked a complete explanation of the present invention (in other words, "lacked essential subject matter") and therefore any matter entered to cure this deficiency can be classified as new matter.

Finally, Applicant is to be advised that the drawing objection to the specification has not yet been overcome. Figures may not be submitted within the body of the specification, as stated in the previous two Office actions.

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

BKA

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25 August 2003



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